

Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed December 15, 2004. Applicant respectfully provides these remarks and requests reconsideration and allowance of all pending claims.

Dependent Claims 6, 16, and 26 are Enabled

The Examiner rejects dependent Claims 6, 16, and 26 under 35 U.S.C. § 112 as failing to comply with the enablement requirement. Claim 6 recites: "The system of Claim 1, wherein the display is three-dimensional and the offer variables for which values are specified in the offers and corresponding to the dimensions comprise price, quantity, and at least one additional offer variable for which values are specified in the offers." Dependent Claims 16 and 26 recite substantially similar limitations. The Examiner states, "The display as understood by the examiner is substantially two dimensional, the dimensions representing price and quantity." (Office Action, Page 2). Based on this understanding, the Examiner argues that "one of ordinary skill in the art would not be able to make or practice the claimed invention without undue experimentation." (Office Action, Page 2). Applicant respectfully disagrees with the Examiner.

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with the information known in the art without undue experimentation." M.P.E.P. § 2164.01 (quoting *United States v. Teletronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988)). There is no requirement that the specification provide concrete examples. In fact, "Compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed." M.P.E.P. § 2164.02. All that is required is that:

[the] information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. Detailed procedures for making and using the invention may not be necessary if the description is sufficient to permit those skilled in the art to make and use the claimed invention.

M.P.E.P. § 2164. Applicant respectfully submits that the Specification provides sufficient information and detail to enable a person skilled in the art at the time of the invention to make and use the claimed invention. To address the Examiner's rejection, Applicant refers

to particular figures and particular portions of the Specification, but such references should not be used to limit any of Applicant's claims.¹

Figures 2-4 illustrate example displays clearly having three dimensions. Each display includes three axes—a price axis, a quantity axis, and a purity axis—and the icons in the display are clearly shown as being positioned with respect to each of the three axes according to the values specified in offers corresponding to the icons. As the Specification makes clear, “per item or other prices for quantities of items for market offers associated with icons . . . may be graphically represented by the locations of [the] icons . . . with respect to a price axis” of the display, “quantities of items for [the] offers associated with [the] icons . . . may be represented by the locations of [the] icons . . . with respect to a quantity axis” of the display, and “purity values for offers may be represented by the locations of icons . . . with respect to [a] purity axis” of the display. (Page 10, Lines 1-14). Applicant respectfully submits that such disclosure would clearly enable a person skilled in the art at the time of the invention to make and use the claimed invention.

The Examiner appears to argue that it is impossible to represent position and shape in three dimensions using a graphical display. Applicant respectfully disagrees. A simple inspection of virtually any photograph, painting, television image, videogame display, or the like readily demonstrates this argument to be erroneous. In addition, the Examiner's argument is in direct contradiction with the Examiner's statement that “providing a three dimensional display . . . is notoriously old and well known in the art.” (Office Action, Page 5). Applicant agrees that there are numerous well-known means for representing position and shape in three dimensions using a graphical display. Even assuming for the sake of argument that the Specification were limited with respect to disclosure of a means for representing position and shape in three dimensions, one skilled in the art would clearly be able to practice the claimed invention, based on the disclosure provided and knowledge generally available, without undue experimentation.

¹ See *Superguide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (stating that the specification of a patent cannot be used to import limitations into a claim that are not recited in the claim to narrow or otherwise change the ordinary meaning of a claim term).

Therefore, Applicant respectfully submits that dependent Claims 6, 16, and 26 are enabled under 35 U.S.C. § 112. For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 6, 16, and 26.

Applicant Does Not Admit to Any Prior Art

Regarding the Examiner's statements related to admitted prior art, Applicant respectfully disagrees. Applicant makes no admission with regard to any reference's status as prior art absent an explicit affirmative statement to the contrary.

Independent Claims 1, 11, 21, and 31-32 are Allowable over *Moshal*

The Examiner rejects independent Claims 1, 11, 21, and 31-32 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0032637 to Moshal et al. ("*Moshal*"). *Moshal* merely discloses an interactive user interface that depicts offers in a radial display including only two dimensions. (Paragraph 0025; Figures 1-17). In *Moshal*, circles in the radial display represent offers. (Paragraph 0027; Figures 1-17). Radial distance of a circle from a center of the radial display represents a price or score of the offer, and a position of the circle measured in radians (or degrees) from a reference point in the radial display represents an amount of time that has elapsed since the offer entered an auction. (Paragraphs 0029 and 0033).

In contrast, independent Claim 1 of the present Application recites:

A system for providing visualization of market offers, comprising a computer system operable to:

receive offer data for a plurality of offers, the received offer data reflecting values specified in the offers for a plurality of offer variables; and

generate a display of the received offer data, the display comprising:

a plurality of dimensions each corresponding to one of the offer variables for which values are specified in the offers and comprising a range of values of that offer variable, the dimensions defining a multi-dimensional space, each position within the multi-dimensional space uniquely corresponding to a set of values of the offer variables for which values are specified in the offers; and

a plurality of geometrically-shaped icons, each icon representing one of the offers and being positioned with respect to the dimensions of the display according to the values of the offer variables specified in that offer, the different positions of the offers within the display

allowing a user to readily visually compare the offers in connection with a market decision.

Independent Claims 11, 21, and 31-32 recite substantially similar limitations.

The radial display in *Moshal* cannot be properly considered a display comprising “***a plurality of dimensions each corresponding to one of the offer variables for which values are specified in the offers,***” as recited in independent Claim 1. As discussed above, radial distance of a circle in the radial display in *Moshal* represents a price or score of an offer, and a position of the circle in the radial display in *Moshal* represents an amount of time that has elapsed since the offer entered an auction.

Even assuming for the sake of argument that radial distance in the radial display in *Moshal* could be properly considered a dimension “corresponding to one of the offer variables for which values are specified in the offers,” *Moshal* would still fail to disclose, teach, or suggest a ***plurality*** of such dimensions, as recited in independent Claim 1. A position of a circle measured in radians from a reference point in the radial display in *Moshal* merely represents an amount of time that has elapsed since an offer entered an auction. Nowhere does *Moshal* disclose, teach, or even begin to suggest that such lapsed time can be properly construed as another “one of the offer variables for which values are specified in the offers,” as recited in independent Claim 1.

The Examiner admits that “*Moshal* does not explicitly show that elapsed bid time can be a variable specified in the offer.” (Office Action, Page 4). However, the Examiner states that “time is inherently specified in the act of placing the bid.” (Office Action, Page 7). Based on this statement, the Examiner argues that “both the price and the time of placement are values specified in the offer.” (Office Action, Page 7). Applicant respectfully disagrees.

“In relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art.” M.P.E.P. § 2112 (quoting *Ex Parte Levy*, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has not satisfied this requirement.

It does not necessarily flow from the fact that offers are placed that time of offer is “one of the offer variables for which values are specified in the offers.” Even more clearly, under no circumstances can the amount of time that has elapsed since an offer entered an auction properly be construed as “one of the offer variables for which values are specified in the offers” themselves. This would be logically impossible. At best, *Moshal* merely discloses a display with two dimensions corresponding to price (or value) and an amount of time that has elapsed since an offer entered an auction. Thus, *Moshal* clearly fails to disclose, teach, or suggest “a plurality of dimensions each corresponding to one of the offer variables for which values are specified in the offers,” as recited in independent Claim 1.

Moreover, *Moshal* fails to disclose, teach, or suggest that each position in the radial display in *Moshal* is “uniquely corresponding to a set of values of the offer variables for which values are specified in the offers,” as recited in independent Claim 1. Instead, all positions radially equidistant from a center of the radial display disclosed in *Moshal* represent offer prices or offer scores that are identical to each other. Therefore, each position in the radial display disclosed in *Moshal* does not uniquely correspond to an offer price or offer score. Furthermore, the display disclosed in *Moshal* is substantially circular, and the icons displayed travel around the display in a circular path. Therefore, as time elapses, an icon representing an offer will eventually return to its original location on the radial display. Thus, if two offers were made for the same price but at different times, it is possible for the icons to be positioned in the same location. Therefore again, each position in the radial display disclosed in *Moshal* does not uniquely correspond to an offer price or an offer score. Accordingly, *Moshal* clearly fails to disclose, teach, or suggest that each position in the radial display is “uniquely corresponding to a set of values of the offer variables for which values are specified in the offers,” as recited in independent Claim 1.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). Moreover, “the identical invention must be shown in as complete detail as is contained in the . . . claim.” M.P.E.P. § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). Furthermore, “[t]he elements must be arranged as

required by the claim.” M.P.E.P. § 2131 (citing *In Re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)). As shown above, *Moshal* fails to disclose, teach or suggest, either expressly or inherently, each and every limitation recited in independent Claim 1, as the M.P.E.P. and governing Federal Circuit case law require.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 11, 21, and 31-32 and all their dependent claims.

**Independent Claims 1, 11, 21, and 31-32 are Allowable over the Proposed
Moshal-Bid/Ask Combination**

In addition to the rejections under 35 U.S.C. § 102(e), the Examiner rejects independent Claims 1, 11, 21, and 31-32 under 35 U.S.C. § 103(a) as being unpatentable over *Moshal* in view of certain Bid/Ask Page/Order Book webpages from www.themoment.com (“*Bid/Ask*”).² Applicant respectfully disagrees with the Examiner.

Applicant respectfully submits that the rejection of independent Claims 1, 11, 21, and 31-32 based on the proposed *Moshal-Bid/Ask* combination is improper, because (1) the Examiner has not shown the required teaching, suggestion, or motivation in *Moshal*, *Bid/Ask*, or knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Moshal* and *Bid/Ask* as proposed, and (2) the proposed *Moshal-Bid/Ask* combination does not teach or suggest all of the claim limitations.

A. The Examiner Has Not Properly Established a Teaching, Suggestion, or Motivation to Combine *Moshal* and *Bid/Ask*

1. No Teaching, Suggestion, or Motivation in the Prior Art

Applicant respectfully submits that the rejection of independent Claims 1, 11, 21, and 31-32 based on the proposed *Moshal-Bid/Ask* combination is improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Moshal*, *Bid/Ask*, or

² Applicant notes that *Bid/Ask* is dated after the filing date of the present Application, and is therefore not available as a printed publication under 35 U.S.C. § 102. However, because the proposed combination fails to satisfy the *prima facie* case for obvious for other independent reasons, Applicant does not address this issue in this response. Nevertheless, Applicant makes no admission regarding the reference’s status as prior art, and reserves the right to challenge that status at a later date if the Examiner maintains this rejection.

knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Moshal* and *Bid/Ask* with each other as proposed. Instead, the Examiner merely states, “It would have been obvious to one of ordinary skill in the art to modify the method of *Moshal* by specifying elapsed time as a variable in the offer in order to automatically adjust the offer if it is unsuccessful after a certain period.” However, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given *in the prior art* why one of ordinary skill in the art at the time of the invention would have been prompted to combine the teachings of *Moshal* and *Bid/Ask* to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant’s disclosure. *See id.* (citations omitted). “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.³ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal

³ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references . . .”).

Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

Applicant respectfully submits that the rejection of independent Claims 1, 11, 21 and 31-32 based on the proposed *Moshal-Bid/Ask* combination is improper, under the M.P.E.P. and governing Federal Circuit cases, because the Examiner has not shown the required teaching, suggestion, or motivation in *Moshal*, *Bid/Ask*, or knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Moshal* and *Bid/Ask* with each other as proposed.

2. The Proposed Combination Renders *Moshal* Unfit for its Intended Purpose

As further evidence that the proposed *Moshal-Bid/Ask* combination is improper, the proposed combination renders *Moshal* unfit for its intended purpose. The Examiner proposes

combining the interactive user interface that depicts offers in a radial display, as disclosed in *Moshal*, with *Bid/Ask* “by specifying the elapsed time in as a variable in the offer in order to automatically adjust the offer if it is unsuccessful after a certain period.” (Office Action, Page 4). However, the offer information disclosed in *Bid/Ask* includes information indicating an initial offer price, an adjusted offer price, and a time interval to delay before adjusting the price. If this information were included in the display disclosed in *Moshal*, potential sellers would be provided with information indicating that the purchasers making buy offers were willing to pay more than the initial offer price. Disclosing such information would be contrary to the interests of the buyers and would result in a disruption to the efficient operation of the marketplace. Furthermore, if sellers knew that a buyer intended to stay in the market for a set amount of time, and that the buyer was willing to pay more at a later date, it would discourage sellers from making current offers. Similarly, if buyers knew that sellers would be willing to accept less for a sale at a later date, it would discourage buyers from making current offers. Such disruption would be contrary to the intended purpose of *Moshal*, which is designed to enhance the marketplace through the graphical display of real-time offers. Thus, the modification as proposed would result in a significant disruption to the real-time marketplace intended to be enhanced by the graphical display in *Moshal*.

“If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Thus, at least because the proposed *Moshal-Bid/Ask* combination would render *Moshal* unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed combination, and the combination is therefore improper.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 11, 21 and 31-32 and all their dependent claims.

C. The Examiner’s Proposed Combination Does Not Teach or Suggest All of the Claim Limitations

Independent Claims 1, 11, 21, and 31-32 recite certain limitations that, as shown above, *Moshal* does not disclose, teach, or suggest. Independent Claims 1, 11, 21, and 31-32

are allowable for at least this reason. In addition, even if the proposed *Moshal-Bid/Ask* combination were proper, *Bid/Ask* does not remedy the inadequacies of *Moshal*. Specifically, the proposed *Moshal-Bid/Ask* combination does not disclose, teach, or suggest at least generating a display of the received offer data, the display comprising:

a plurality of dimensions each corresponding to one of the offer variables for which values are specified in the offers and comprising a range of values of that offer variable, the dimensions defining a multi-dimensional space, each position within the multi-dimensional space uniquely corresponding to a set of values of the offer variables for which values are specified in the offers.

This limitation is recited in each of the independent claims.

As shown above, *Moshal* does not disclose, teach, or suggest that each position in the radial display is “uniquely corresponding to a set of values of the offer variables for which values are specified in the offers.” This inadequacy of *Moshal* would not be overcome by the proposed combination of *Moshal* and *Bid/Ask* by “specifying elapsed time in as a variable in the offer,” even if the proposed combination were proper. In the proposed combination, if two offers were made for the same price but specified different elapsed times, it is possible for the icons to be positioned in the same location due to the circular path of the icons. Accordingly, the proposed *Moshal-Bid/Ask* combination clearly fails to disclose, teach, or suggest that each position in the radial display is “uniquely corresponding to a set of values of the offer variables for which values are specified in the offers,” as recited in each of the independent claims.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 11, 21, and 31-32 and their dependent claims.

**Dependent Claims 6, 16, and 26 are Allowable over *Moshal* and the proposed
Moshal-Bid/Ask Combination**

The Examiner rejects dependent Claims 6, 16, and 26 under 35 U.S.C. § 102(e) as being anticipated by *Moshal* and under 35 U.S.C. § 103(a) as being unpatentable over *Moshal* (or in the alternative *Moshal* in view of *Bid/Ask*). Applicant respectfully disagrees.

Dependent Claim 6 of the present Application recites, “The system of Claim 1, wherein the display is three-dimensional and the offer variables for which values are specified in the offers and corresponding to the dimensions comprise price, quantity, and at least one additional offer variable for which values are specified in the offers.” Dependent Claims 16 and 26 recite substantially similar limitations.

At a minimum, Claim 6 depends on independent Claim 1, shown above to be allowable. In addition, *Moshal* and the proposed *Moshal-Bid/Ask* combination fail to disclose, teach or suggest the further limitations recited in dependent Claim 6. As an example, *Moshal* and the proposed *Moshal-Bid/Ask* combination fail to disclose, teach, or suggest a display that is “three-dimensional.” The Examiner even acknowledges that *Moshal* and *Moshal* in view of *Bid/Ask* do not disclose “a three-dimensional display representing at least price, quantity, and one other variable.” (Office Action, Page 5) The Examiner states:

However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the apparatus of *Moshal et al* by providing the information in order to provide further information at a glance.

As indicated above, Applicant acknowledges that there are numerous well-known means for representing position and shape in three dimensions using a graphical display. However, if these statements by the Examiner are intended as Official Notice that providing a system “wherein the display is three-dimensional and the offer variables for which values are specified in the offers and corresponding to the dimensions comprise price, quantity, and at least one additional offer variable for which values are specified in the offers” was old and well known at the time of the invention, Applicant respectfully traverses the Official Notice because the asserted facts are not supported by documentary evidence.

“Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted

by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute’” M.P.E.P. § 2144.03 (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)). “It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” M.P.E.P. § 2144.03 (emphasis in original).

The Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. Instead, it appears that the asserted facts are opinions that have been formulated using the present application as a template, which constitutes impermissible use of hindsight. If the Examiner continues to maintain his rejection of Claims 6, 16, and 26 based on this reasoning, then Applicant requests the Examiner to provide documentary evidence in the next Office Action, as required in M.P.E.P. § 2144.03(C). Further, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. (See M.P.E.P § 2144.03(C)).

For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 6, 16, and 26.

Conclusion

For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes that a telephone conference would advance prosecution of this Application, the Examiner is invited to call Christopher W. Kennerly, Attorney for Applicant, at 214-953-6812.

Applicant believes no fee is due. Nonetheless, the Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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